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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/007,866

12/06/2001

Vijay Kumar

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6560

22885 7590 07/16/2007
MCKEE, VOORHEES & SEASE, P.L.C.
801 GRAND AVENUE
SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

WHITE, EVERETT NMN

ART UNIT

PAPER NUMBER

1623

MAIL DATE

DELIVERY MODE

07/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/007,866

Applicant(s)

KUMAR ET AL.

Examiner

Everett White

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on April 27, 2007 has been entered.

2. The amendment filed April 27, 2007 has been received, entered and carefully considered. The amendment affects the instant application accordingly:

- (A) Claims 1-35 and 37-40 have been canceled;
- (B) Comments regarding Office Action have been provided drawn to:
 - (I) 112, 1st paragraph rejection, which has been maintained.

3. Claim 36 is pending in the case.

Specification

4. The amendment filed April 27, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The sentence disclosed on page 13, line 29, which reads "[T]he resulting solid, having a carboxylic content of 10.57% and acid number of 133.9, was filtered, washed with water... . In the remarks, Applicants disclose support for the newly added text by indicating that in Example 1 of the application, the carboxylic content of oxidized cellulose is approximately 14% (Decl. V. Kumar, para. 7). Applicants disclosed that as determined by titration, the resulting oxidized cellulose acetate produced in this example had a

carboxylic content of 10.57%. (Decl. V. Kumar, para. 7). Thus, in accordance with the formula described in paragraph 6 of Dr. Kumar's declaration, Applicants disclose that the acid number of the compound is 133.9, as follows:

$$\{[10.57 \text{ (g)/45}] * 57\} * 1000/100 \text{ (g)} = 133.9 \text{ (Decl. V. Kumar, para. 8).}$$

Applicants state that for all of these reasons, the application, as filed, demonstrates that the compound synthesized in Example 1 inherently has a carboxylic acid content of 10.57%, and that this carboxylic content of 10.57% directly converts to an acid number of 133.9. (Decl. V. Kumar, para. 9).

The explanation in Applicants remarks and the declaration of Dr. Vijay Kumar are not convincing since for at least the fact that Example 1 of the instant specification discloses a specific value 13.7% for the carboxylic content of the oxidized cellulose. The phrase "approximately 14%" was not noted and therefore is not supported in the instant specification. Hence, the carboxylic content value of 10.57% and the acid number value of 133.9 for the oxidized cellulose acetate are base on a number that is not supported in the instant specification. Furthermore, the equation used by Applicants to calculate the acid number was not noted in the instant specification, which further supports that the added text sets forth new matter. In view of the lack of support of said carboxyl content values in the oxidized cellulose and oxidized cellulose acetate, the acid number value of the oxidized cellulose acetate, and the equation cited for use to calculate the acid number of the oxidized cellulose acetate in the instant specification, an objection under 35 U.S.C. 132(a) because of introduction of new matter in the amendment filed April 27, 2007 is disclosed.

Applicants attention is directed to MPEP 2165.01, paragraph V. Defect in Best Mode Cannot be Cured by New Matter, which discloses that if the best mode contemplated by the inventor at the time of filing the application is not disclosed, such a defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed. In re Hay, 534 F.2d 917, 189 USPQ 790 (CCPA 1976). Any proposed amendment of this type (adding a specific mode of practicing the invention not described in the application as filed) should be treated as new matter. New matter under 35 U.S.C. 132

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and 251 should be objected to and coupled with a requirement to cancel the new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants amended Claim 36 by incorporating into the claim the text "said biodegradable oxidized cellulose ester having an acid number of at least 133". Applicants point to Example 1, page 13, line 26 of the instant specification for support of this amendment to Claim 36 wherein it states the starting material for synthesis of the compound in the example has a carboxylic content of 13.7%. Applicants argue that the resulting compound has a carboxylic content of 10.57%, which converts to an acid number of 133.9. However, the conversion of the carboxylic content 10.57% to an acid number of 133.9 in Example 1 is insufficient documentation for support of claim limitation since Example 1 in the instant specification does not disclose the carboxylic content of the resulting compound thereof and does not set forth the acid number of the resulting compound. Accordingly, the amendment of Claim 36 to set forth the acid number of the claimed oxidized cellulose ester thereof sets forth new matter, which is improper and fails to comply with the written description requirement of the first paragraph of 35 U.S.C. 112. Furthermore, support is not found for use of the phrase "at least" disclosed in the text "at least 133" in Claim 36.

Summary

7. Claim 36, the only pending claim, is rejected.


Examiner's Telephone Number, Fax Number, and Other Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is 571-272-0660. The examiner can normally be reached on 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


E. White

 7/6/07
Shaojia A. Jiang
Supervisory Primary Examiner
Technology Center 1600